

37. A gaming apparatus as defined in claim 36 wherein said gaming apparatus is programmed to determine a first default payout amount for said hopper and a second default payout amount for said cashless payout apparatus.

38. A gaming apparatus as defined in claim 37, wherein said gaming apparatus is programmed to allow said player to adjust said first default payout amount and said second default payout amount.

39. A gaming apparatus as defined in claim 36, wherein said gaming apparatus is programmed to compare said player cash out amount to a coin pay limit.

40. A gaming apparatus as defined in claim 39 wherein said gaming apparatus is programmed to pay to said player said cash out amount from said hopper if said player cash out amount is less than or equal to said coin pay limit.

41. A gaming apparatus as defined in claim 36, wherein said gaming apparatus is programmed to pay to said player said cash out amount from said hopper if said cashless payout apparatus is not available.

REMARKS

In the Office Action, claims 1-10, 16, and 17 were rejected under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 5,980,384 to Crevelt, and claims 11-15 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Crevelt in view of U.S. Patent No. 5,813,510 to Rademacher. Crevelt and Rademacher are hereinafter referred to as "the applied patents."

In the above amendments new claims 19-41 have been added. A supplemental information disclosure statement is also submitted herewith.

In view of the above amendments and the following remarks, reconsideration of the application is respectfully requested.

Amendments to the Specification

The original "Summary of the Invention" section of the specification has been replaced with a new summary section that is consistent with the new claims pursuant to 37 C.F.R. § 1.73, which states that "Such summary should, when set forth, be commensurate with the invention as claimed..."

Support For New Claims Added

It is respectfully submitted that the new claims are supported by the present application as filed in the Patent and Trademark Office, that the new claims satisfy the written description requirement and the other requirements of 35 U.S.C. §112, and that no new matter is being added.

It is well settled that the specification need not reproduce the exact language of the claims to satisfy the written description requirement of §112, first paragraph. In re Wright, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (“the claimed subject matter need not be described in haec verba in the specification in order for that specification to satisfy the description requirement”). The written description requirement of §112 can even be satisfied based solely on the drawings of a patent application. Vas-Cath Inc. v. Mahurkar, 19 U.S.P.Q.2d 1111, 1118 (Fed. Cir. 1991) (“These cases support our holding that, under proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by §112”).

It is submitted that the present application discloses that the software shown in Figs. 3-9 is performed by a gaming apparatus (i.e. a “gaming apparatus being programmed ...”) since any computer program, such as the program disclosed in the application, is necessarily executed or performed by a gaming apparatus that includes a processor and a memory.

Claim Construction

Although the present application describes various embodiments and makes various statements regarding the “invention,” it is well settled that the legal scope of the invention is defined by the words of the claims and that it is improper to read features of the embodiments described in the specification of a patent into the claims. It should also be recognized that the term “invention” may be used to mean various different things. For example, the term “invention” may be used to refer to the technical subject matter that has been invented; the term “invention” may be used to refer to subject matter which is nonobvious; and the term “invention” may be used to refer to subject matter defined by the claims of a patent.¹ Thus,

¹ This is explained in the Glossary of Volume 1 of Chisum on Patents, where the term “invention” is defined as follows:

the mere fact that the present application uses the term "invention" in various statements does not mean that the scope of the claims is limited by such statements.

It should also be understood that, unless a term is expressly defined in the present application using the sentence "As used herein, the term '_____' is hereby defined to mean..." or a similar sentence, there is no intent to limit the meaning of that term, either expressly or by implication, beyond its plain or ordinary meaning, and such term should not be interpreted to be limited in scope based on any statement made in any section of the present application (other than the language of the claims). Finally, unless a claim element is defined by recital of the word "means" and a function without the recital of any structure, it is not intended that the scope of any claim element be interpreted based on the application of 35 U.S.C. § 112, sixth paragraph.

It is respectfully submitted that the foregoing comments regarding claim construction are consistent with 35 U.S.C. §112 and the Office practice of utilizing the "broadest reasonable interpretation" of claims.

Discussion

It is respectfully submitted that neither of the applied patents appears to disclose or suggest: (1) a gaming apparatus being programmed to determine if a cashless payout apparatus is available for a player cash out amount; (2) the gaming apparatus being programmed to compare a player cash out amount to a coin pay limit; (3) the gaming apparatus being programmed to determine if a split pay option is available if a player cash out amount is greater than the coin pay limit; and (4) the gaming apparatus being programmed to pay to a player a first amount equal to said coin pay limit from said hopper and to pay to said player a second amount equal to said player cash out amount minus said coin pay limit utilizing said cashless payout apparatus, if said split pay option is available; as recited in new independent claim 19. Therefore, it is respectfully submitted that claim 19 is allowable over the applied patents.

INVENTION – In patent law, the word 'invention' has several different meanings. It may refer to (1) the act of invention through original conception and reduction to practice; (2) subject matter described and/or claimed in a patent, patent application or prior art reference (e.g., a product or process); or (3) the patentability requirement of invention, first developed by the courts and now subsumed in the statutory requirement of nonobviousness. Thus, an applicant may have invented (1) an invention (2) which is unpatentable for lack of invention (3) because it is an obvious modification of an invention (2) used by others in this country before the invention (1) thereof by the applicant.

It is further submitted that neither of the applied patents appears to disclose or suggest: (1) a gaming apparatus being programmed to determine if a split pay option is available; (2) the gaming apparatus being programmed to receive a distribution input from a player corresponding to a player cash out amount if said split pay option is available, said distribution input being a portion of said player cash out amount that said player wants to receive from a hopper; and (3) the gaming apparatus being programmed to pay to said player a first amount equal to said distribution amount from said hopper and to pay to said player a second amount equal to said player cash out amount minus said distribution amount utilizing a cashless payout apparatus, if said split pay option is available; as recited in new independent claim 26. Therefore, it is respectfully submitted that claim 26 is allowable over the applied patents.

Applicants also submit that neither of the applied patents appears to disclose or suggest: (1) a gaming apparatus being programmed to determine a first default payout amount for a hopper and a second default payout amount for a cashless payout apparatus; (2) the gaming apparatus being programmed to determine if a player is allowed to modify said first and said second payout amounts; (3) the gaming apparatus being programmed to receive an input from said player, said input corresponding to a first modified payout amount to be paid to said player from said hopper and a second modified payout amount to be paid to said player from said cashless payout apparatus, wherein the sum of said first modified payout amount and said second payout amount equals said cash out amount; and (4) the gaming apparatus being programmed to pay to said player said first modified payout amount from said hopper and to pay said second modified payout amount utilizing said cashless payout apparatus; as recited in new claim 32. Therefore, it is respectfully submitted that claim 32 is allowable over the applied patents.

Applicants respectfully submit that new independent claim 36 also recites the three elements noted above with reference to new independent claim 26 which are not disclosed or suggested by either of the applied patents. Therefore, it is respectfully submitted that claim 36 is also allowable over the applied patents.

Conclusion

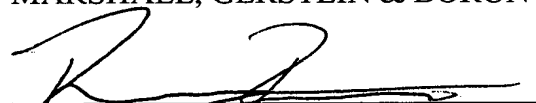
In view of the foregoing, it is respectfully submitted that the above application is in condition for allowance. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN

Date: October 7, 2002

By:



Randall G. Rueth
Registration No. 45,887
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-630